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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,190	07/30/2001	Takashi Minami	TOS-148-USA	7576
7590	08/11/2003			

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EXAMINER  
HOWARD, SHARON LEE

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 08/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/890,190

Applicant(s)

MINAMI ET AL.

Examiner

Sharon L. Howard

Art Unit

1615

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 4/11/03, 4/24/03, 5/30/03.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1,2 and 5-7 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2 and 5-7 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

Examiner acknowledges receipt of change of address of 4/11/03, IDS filed on 4/24/03 and request for one month extension of time and Amendment C filed on 5/30/03.

Claims 3 and 4 have been cancelled.

New claims 5-7 have been added.

Claims 1,2,5-7 are now pending in the application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remain rejected under 35 U.S.C. 102(b) as being anticipated by the JP '713 Abstract.

The JP abstract discloses The JP '713 abstract discloses 10-20% of a polyethylene wax which has an average molecular weight of 300 to 700, 0.5-50% of a liquid oil (i.e. olive oil and liquid paraffin.

The abstract meets the limitation of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 and the newly added claims 5-7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Soyama et al. (USP 5,672,339).

Soyama teaches a composition for rouge for the lips (see abstract), wherein the composition comprises 10-40% of a nonvolatile oil content (col.2, lines 40) comprising glyceryl diisostearate and glyceryl triisostearate (col.4, lines 24 and 26), including other liquid oils comprising olive oil and liquid paraffins (col.4, line 23), 5 to 25% (col.3, line 8) of waxes which are known as a shape-retaining agent for forming a lipstick (e.g. polyethylene wax and microcrystalline wax (col.4, lines 49-57 and col.9, lines 63). Soyama discloses at (Example 1-4, col.38) a lipstick formulation comprising 8.0% of polyethylene wax and at (Example 3-3, col.40) an emulsification-type lipstick preparation comprising 4.0% of microcrystalline wax.

Soyama does not teach the particular mass ratio parameters.

However, it would have been obvious to the skilled artisan to optimize the particular parameters in order to achieve the desired lipstick composition. (**See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Soyama. One having ordinary skill in the art would have been motivated to prepare the lipstick composition of Soyama comprising polyethylene wax and liquid oils.

The particular parameters are not critical over the prior art teaching a lipstick composition which comprises polyethylene wax and microcrystalline wax.

The expected result would be a lipstick composition comprising polyethylene wax, and a liquid oil.

***Response to Arguments***

Applicant's arguments filed 5/30/03 have been fully considered but they are not persuasive. Applicant argues that the cited JP 59-148713 reference discloses neither the microcrystalline wax, nor the mass ratio of polyethylene wax to microcrystalline wax, now claimed herein. The present lipstick composition provides the same or better shape-retaining characteristics of the cited Soyama reference lipstick compositions without using ceresin wax as a shape-retaining agent therein.

In response to applicant's argument, Soyama uses ceresin wax in the lipstick composition. However, it would have been obvious to the ordinary practitioner to claim the ceresin-free lipstick composition given the teachings of Soyama et al. The composition is not limited exclusively to ceresin, (see col.4,lines 49-57) Soyama discloses other waxes such as microcrystalline wax, polyethylene wax, carnauba wax, candelilla wax, paraffin wax, including alcohols which can be used in the composition.

In conclusion, the prior art teaches a lipstick composition having improved adhesion properties, therefore the lipstick would have the same shape-retaining characteristics.

The rejection set forth above is maintained for reasons of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Howard whose telephone number is (703) 308-4359. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3121 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Sharon Howard  
August 8, 2003

CARLOS A. AZPURA  
PRIMARY EXAMINER  
GROUP 1500